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10/679,275	10/10/2003	Martin B. Bushman	INTCOM.001A	7516
20995 7590 07/16/2008 KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614				
EXAMINER				
FERTIG, BRIAN E				
ART UNIT		PAPER NUMBER		
3694				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/679,275

Applicant(s)

BUSHMAN ET AL.

Examiner

BRIAN FERTIG

Art Unit

3694

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Information Disclosure Statement

1. The Appendix to the specification is not a proper information disclosure. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, identification of their respective authorship, publisher, date, and location of publication. The Appendix appears to be a document separate from the specification. Inclusion of the Appendix on the Information Disclosure Statement is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 2 is rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5,465,206 to Hilt, 1995 (Hilt).

With respect to claim 2

Hilt teaches:

A secure messaging system (Bill Pay System see Abstract) for supporting financial transactions with finality between a first client (Consumer C e.g. 12, see col 12, line 51) having an account at a first financial institution (Bank C e.g. 16, see col 12, line 52) and a second client (Biller B e.g. 14, see col 12, lines 51-52)

having an account at a second financial institution (Bank B e.g. 18, see col 12, line 52), the secure messaging system comprising:

a transfer network system (Payment Network e.g. 102, see col 12, line 53) comprising a messaging server (Clearing Subsystem e.g. 106 see col 13, see lines 20-21 and col 16, lines 4-9) configured to send and receive messages from a communications medium (Links see col 4, lines 12 - 15) and further comprising an audit database (Transaction Logger e.g. 164, see col 16, lines 41-43);

a first client system (personal computer see Col 7, Lines 23 – 28) connected to the transfer network system via the communications medium, the first client system being associated with the first client;
a second client system (customer general ledger, col 4, lines 49-57, note the ledger is understood to be on a computing medium as it includes a database updated from a system having read a MICR encoded check) connected to the transfer network system via the communications medium, the second client system being associated with the second client;

a validation server (card reader e.g. 322, see col 22, lines 18-27) in communication with the transfer network system, the validation server configured to provide authentication of the identity of at least one individual user of the first client having authority to assent to the payment of funds from an account of the first client to an account of the second client,

a first financial institution client system (Bank C see col 12, lines 53 - 58) connected to the transfer network system via the communications medium and associated with said first financial institution, the first financial institution having a first account holding funds of the first client; and

a second financial institution client system (Bank B see col 12, lines 53 - 58) connected to the transfer network system via the communications medium and associated with said second financial institution, the second financial institution having a second account holding funds of the second client.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,292,789 to Schutzer, September, 2001 (Schutzer) in view of *Control Principles and Role Hierarchies* by J.D. Moffett, ACM, 1998 (Moffett).

With respect to claim 1

Schutzer teaches:

A method for finalizing an electronic fund transfer that is matched to an invoice for payment to be made from a first party (consumer 100, see col 14, lines 18-25) having a financial account at a first bank (consumer payment processor 138, see col 14, lines 18-25) to a second party (Biller 106, see col 14, lines 18-29) having a financial account at a second bank (biller payment processor 142, see col 14, lines 18-25) using a network transfer system (collectively consumer service provider 102, payment processor 156, and tracking entity 154, see col 15, lines 3-36) that is in electronic communication (computer network, see Abstract) with the first party, the second party, the first bank and the second bank, the method comprising:

generating at the first party a document which authorizes the payment of the invoice (electronic mail with payment instructions, see col 15, lines 3-6);

signing the document using a first digital certificate in accordance with a procedure of a certificate authority in electronic communication with the transfer network system to produce a

signed document (sending a digitally signed electronic mail with payment instruction, see col 15, lines 4-6);

sending the signed digital document from the first party to the network transfer system electronically (sending a digitally signed electronic mail with a payment instruction to his or her payment processor, see col 15 lines 4-6);

authenticating via the certificate authority the authority of a signer of the signed document to assent to payment of the invoice (the payment processor decrypts and authenticates the payment instruction, see col 15, lines 20-21);

storing a copy of the signed digital document in a database associated with the transfer network system (the consumer service provider logs the request, see col 20, lines 6-8);

sending a copy of the signed payment authorization request to the first bank (The consumer service provider processes payment through its consumer payment processor, see col 14, lines 21-23);

creating an electronic payment instruction verifying a transfer of funds out of the financial account of the first party at the first bank (The consumer payment processor . . . may provide optional status reporting, see col 14, lines 21-23);

sending this electronic payment instruction from the first bank to the transfer network system (The payment processor acknowledges that is has submitted the payment for processing back to the appropriate tracking entity, see col 15, lines 23-25);

forwarding the electronic payment instruction to the second bank (The consumer payment processor clears and settles payment, see col 14, lines 21-22);

creating an electronic payment receipt verifying the transfer of funds into the financial account of the second party at the second bank (the payment processor acknowledges receipt of funds, see col 15, lines 27-28); and

sending the electronic payment receipt from the second bank to the transfer network system (the payment processor acknowledges receipt of funds to the tracking entity, see co 15, lines 27-29).

Schutzer does not explicitly teach:

sending a payment authorization request from the network transfer system to the first party;

signing of the payment authorization request using a second digital certificate in accordance with the procedure of the certificate authority;

sending the signed payment authorization request from the first party to the network transfer system electronically;

authenticating via the certificate authority the authority of the signer of the signed payment authorization request to assent to the transfer of funds from the financial account of the first party at the first bank to the financial account of the second party at the second bank;

storing a copy of the signed payment authorization request in the database associated with the transfer network system.

Moffett teaches:

sending a payment authorization request from the network transfer system (system) to the first party (i.e. the business transacting their payment process on the system. Note the Account Supervisor, acting as a representative for the first party, approves the Accounts Payable after Accounts Payable Clerk, also acting as a representative for the first party, has prepared the payment authorization by inputting details of the invoices into the system, see sec 4.1 pg 66 and fig 5. Note also, that it is inherent that the Accounts Payable document be sent to the Account Supervisor's screen for review and approval);

signing of the payment authorization request using a second digital certificate in accordance with the procedure of the certificate

authority (i.e. Account Supervisor approves Accounts Payable, see pg 66. Note that a signature is a well known form of signifying approval. Note also that this is a repetition of a step already taught by Schutzer that produces no unexpected results);

sending the signed payment authorization request from the first party to the network transfer system electronically (Supervisor releases Accounts Payable for payment. Note, it is implicit that the payment authorization is released back to the system and Fig 5 indicates that a computer system is used to store data. Further note that in Accounts Payable Review, 'digital signatures' are discussed as being the equivalent of an ink signature. Note also that this is a repetition of a step already taught by Schutzer that produces no unexpected results. Note too that the difference in documents – i.e. signed payment authorization v signed payment authorization request - would also have no effect on the operation of the method);

authenticating via the certificate authority the authority of the signer of the signed payment authorization request to assent to the transfer of funds from the financial account of the first party at the first bank to the financial account of the second party at the second bank (Note this is a repetition of the step already taught by Schutzer that produces no unexpected results.);

storing a copy of the signed payment authorization request in the database associated with the transfer network system (Note that this is a repetition of the step already taught by Schutzer that produces no unexpected results. Note too that the difference in documents – i.e. signed payment authorization v signed payment authorization request - would also have no effect on the operation of the method.) all in order to achieve separation of duties and decentralization motivated by control theory (see pg 64).

It would have been obvious to one having ordinary skill in the art at the time of applicant's invention to have provided the method for finalizing an electronic fund transfer taught by Schutzer with the control principle motivated steps of Moffett in order to achieve a separation of duties and decentralization as taught explicitly by Moffett (see pg 64).

Response to Arguments

7. Applicant's arguments, see Remarks, filed 5/9/2008, with respect to the Objections to claims 1 and 2 have been fully considered and are persuasive in view of Applicant's amendments. The Objection to claims 1 and 2 has been withdrawn.
8. Applicant's arguments filed 5/9/2008 related to Examiner's rejection of claims 1 and 2 under 35 U.S.C. 102 and 103 have been fully considered but they are not persuasive. With respect to the argument that Moffet does not teach or suggest the second digital signature, Examiner respectfully disagrees. In support of this argument,

Applicant cites the teaching in **Moffett** of the review of accounts payable of the second signature and points out that the review is conducted at a later time. Examiner asserts that the second digital signature suggested by **Moffett** is the signature applied by the Account Supervisor in the course of approving and releasing the Accounts Payable (see pg 66). Note that "the Approval action is an integral part of the transaction; until it has been carried out the system cannot release funds, and after it has been carried out successfully nothing can stop the flow of funds" (see pg 67). As such, **Moffett** does, in fact, render obvious the claimed second electronic signature. Examiner suggests, that the review that is post hoc and capable of detecting irregularities cited by Applicant, refers to the review performed by auditors.

9. With respect to the argument that card reader is not an authentication server, Examiner respectfully disagrees. **Hilt** teaches, ". . . authorization for a bill pay order is assured by providing a machine-readable card and card reader to consumer C. Card reader 322 is coupled to Service Bureau 312 and Bank C 304 *and indicates whether customer C is in possession of machine-readable card 320. If consumer C is in possession of machine-readable card 320 . . . card reader 322 will transmit this event and it will be considered evidence of authorization for the bill pay order.*" (see col 22, lines 18-27). The teaching in **Hilt** makes it clear that the card reader is an integral part of the authentication and is configured to provide authentication of the identity of at least one individual user of the first client having authority to assent to the payment of funds

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
11. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **BRIAN FERTIG** whose telephone number is (571)270-5131. The examiner can normally be reached on Monday - Friday 8:30am to 5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3694

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/B.F./

/Mary Cheung/
Primary Examiner, Art Unit 3694